

### **REMARKS/ARGUMENTS**

This application has been reviewed in light of the Office Action mailed on May 7, 2007. Claims 1-23 are pending in the application with Claims 6 and 9-20 being previously withdrawn from consideration and with Claims 1 and 21-23 being in independent form. In view of the amendments and remarks to follow, reconsideration and allowance of this application are respectfully requested.

#### **Claim Rejections – 35 U.S.C. §103(a)**

Claims 1-5, 7-8 and 21-23 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,932,816 to Phan in view of U.S. Patent No. 6,086,586 to Hooven. Phan relates to an apparatus for converting a clamp into an electrophysiology device. Hooven discloses a bipolar tissue grasping apparatus and tissue welding method.

Independent Claim 1 and 21-23 each require a tissue or vessel sealing instrument, including, *inter alia*, jaw members including an elastomeric material disposed on an inner facing tissue contacting surface. In the previous Office Action of December 7, 2006, it was asserted that a base member 106 of Phan is an elastomeric material disposed on an inner facing tissue contacting surface. Applicants responded by arguing, *inter alia*, that the elastomeric material of Phan is not disposed on an **inner facing tissue contacting** surface.

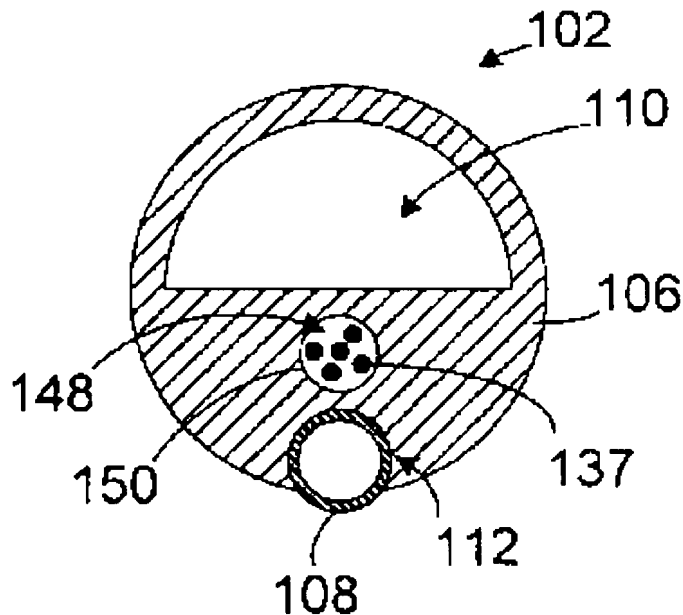
In the current Office Action, it is again asserted that Phan discloses a tissue or vessel sealing instrument, comprising, *inter alia*, first and second jaw members each “including an elastomeric material 106 disposed on an inner facing tissue contacting surface thereof” and “each of the elastomeric materials including an electrode 108

disposed therein, the elastomeric material being adapted to compress or deflect about 0.001 inches to about 0.015 inches when the force used to close the jaw members is between about 40 psi to about 230 psi.”

Specifically, “the Examiner maintains that a large portion of elastomeric base member 106 is disposed on an inner facing tissue contacting surface of each jaw member.” Additionally, it is contended that FIG. 8 of Phan “clearly shows that elastomeric base member 106 encompasses the electrode 108 and forms a large surface area surrounding the electrode that contacts tissue on the inner surface of each jaw member.”

Applicants believe that the Examiner has not accurately considered all of the limitations of the claims. In particular, the Examiner has mistakenly asserted that the elastomeric base member 106 of Phan is disposed on an inner facing tissue contacting surface of each jaw member, as cited by the Applicants’ claims. In making this assertion, the Examiner refers to FIG. 8 of Phan (reproduced below) and indicates that the elastomeric base member 106 **encompasses** the electrode 108. Additionally, it is asserted that the elastomeric base member 106 forms a large surface area **surrounding the electrode** that contacts tissue.

Fig. 8



Upon a detailed review of FIG. 8 of Phan, it is evident that the Examiner's assertion is incorrect. Firstly, the elastomeric base member 106, does not **encompass** the electrode 108, as the elastomeric base member 106 does not "form a circle or ring around", or "surround" the electrode 108.<sup>1</sup> Furthermore, the elastomeric base member 106 does not form a large surface area **surrounding** the electrode. By contrast, reference number 108 is referring to the hatched ring around and in conjunction with the non-hatched circle. Thus, it is clear that the elastomeric base member 106 **does not encompass or surround** the electrode 108; rather, the elastomeric base member 106 of Phan is adjacent the electrode 108.

Therefore, while the electrode 108 of Phan may be disposed on a tissue contacting surface, it is clear that the elastomeric base member 106 of Phan is not

<sup>1</sup> *The American Heritage® Dictionary of the English Language, Fourth Edition*  
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disposed on a tissue contacting surface, as required by the claims of Applicants' disclosure. Further, Hooven fails to cure this deficiency. Thus, the combination of Phan and Hooven fails to disclose, either alone or in combination, the limitations required by independent Claims 1 and 21-23.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of this rejection and earnestly seek allowance of Claims 1 and 21-23, and Claims 2-5 and 7-8, which depend from Claim 1.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all claims presently pending in the application, namely Claims 1-5, 7-8 and 21-23, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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